REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 102

Claims 1-5 and 12-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,994,710 ("the Knee patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 1-5

Since claim 1 has been canceled, this ground of rejection is moot with respect to claim 1.

Claim 4 has rewritten in independent form to include the features of canceled claim 1. Each of claims 2 and 3 has been amended to depend from claim 4.

Independent claim 4 is not anticipated by the Knee patent because the Knee patent does not teach a method including (a) capturing a plurality of image parts by focusing light reflected from a surface onto an image pickup device, (b) determining position information corresponding to each of the plurality of image parts accepting, by ***the*** image pickup device, light reflected from the surface, and (c) generating image information using, at least, the plurality of image parts and the corresponding position information. As can be appreciated from the claim language, the ***same*** image pickup device is use for both capturing a plurality of image parts and for determining position information corresponding to each of the image parts. (See, e.g., the embodiments of Figures 2 and 3.)

On the other hand, the Knee patent apparently includes two image pickup devices for navigation (e.g., position determination), and a linear contact image sensor (CIS) (or a CCD) for picking up image parts. The Knee patent does not disclose using the same image pickup device for ***both*** capturing image parts (from which a larger image is generated) and for navigation or positioning. Accordingly, claim 4 is not anticipated by the Knee patent for at least this reason.

Since claims 2, 3 and 5-7 depend, either directly or indirectly, from claim 4, these claims are similarly not anticipated by the Knee patent.

Claims 12-18

Independent claim 12 is not anticipated by the Knee patent because the Knee patent does not include (a) means for capturing a plurality of image parts, and (b) means for determining position information corresponding to each of the plurality of image parts. The Court of Appeals for the Federal Circuit has instructed:

> The plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. Paragraph six does not state or even suggest that the PTO is exempt from this mandate, and there is no legislative history indicating that Congress intended that the PTO should be.

In re Donaldson Co. Inc., 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)(en banc).

The specification describes various means for capturing a plurality of image parts, and means for determining position information corresponding to each of the plurality of image parts. (See, e.g., Figures 2-5 and the associated description.)

The Examiner has not shown how the structure of the Knee patent is the same or equivalent to the structure described in the specification. Thus, independent claim 12 is not anticipated by the Knee patent for at least this reason. Since each of claims 13-18 depends from

claim 12, these claims are similarly not anticipated by the Knee patent.

Rejections under 35 U.S.C. § 103

Claims 6-11 and 19-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Knee patent in view of U.S. Patent No. 6,657,184 ("the Anderson patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 6 and 7

The Anderson patent is cited as teaching a second light source. First, regarding claims 6 and 7, even assuming, arguendo, that the Anderson includes this purported teaching, and further assuming that one skilled in the art would have been motivated to combine the references as proposed by the Examiner, the purported teaching of the Anderson patent still does not compensate for the deficiencies of the Knee patent with respect to claim 4. Since claim 6 depends from claim 4 and since claim 7 depends from claim 6, these claims are allowable for the same reason as claim 4 discussed above.

Claims 19-25

Similarly, since the purported teaching of the Anderson patent still does not compensate for the deficiencies of the Knee patent with respect to claim 12, and since claims 19-25 depend, either directly or indirectly from claim 12, these claims are allowable for the same reason as claim 12 discussed above.

Claims 8-11

Claim 8, as amended, is not rendered obvious by the Knee and Anderson patents. In the rejection of claim 8, the Examiner alleges that the specification and drawings do not show the second imaging device and that she would therefore interpret the second imaging device to be a combination of the first imaging device with the second light source. The applicants respectfully direct the Examiner's attention to Figure 4 which includes two imaging devices 410 and 470 for pickup, as well as Figure 5 which includes two imaging devices 510 and 570 for pickup. Claim 8, as amended, more clearly recites a first image pickup device and a second image pickup device. Thus, claim 8, as amended, is not rendered obvious by the Knee and Anderson patents for at least this reason.

Since claims 9-11 depend, either directly or indirectly, from claim 8, these claims are similarly not rendered obvious by these patents.

Motivation to Combine

Finally, the applicants respectfully note that the multiple light sources and sensor areas in the Anderson patent are only used for navigation, and are for the purpose of improving navigation when an optical mouse is used on certain surfaces (e.g., grainy surfaces which can cause errors in optical mice). ***There is no suggestion to use multiple light sources where one is used for purposes of capturing image parts (which are to be combined) and the other is used for purposes of determining positions of the captured image parts.*** Thus, one skilled in the

art would not have been motivated to combine the teachings of these patents in a way that renders the claimed invention obvious.

New claims

New claims 26 and 27 depend from method claims 4 and 8, respectively, and further recite that the image parts are captured from a paper document, and that the act of generating image information using at least the plurality of image parts and the corresponding position information, uses the image parts to compose a larger image. These claims are supported, for example, by Figures 6 and 7 and section 4.2 of the specification.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Respectfully submitted,

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CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on **June 13,2006** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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